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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,915	09/11/2003	Eric Restani	790_015DIV	6011
25191	7590	06/07/2005	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,915

Applicant(s)

RESTANI, ERIC

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed April 12, 2005 has been entered. Claims 17-27 are pending, and claims 23-27 are withdrawn as being directed to non-elected species. Claims 17-22 are under consideration on their merits.

Drawings

The substitute drawings were received on April 12, 2005. These drawings are not approved. The depiction of arm 50 contacting the lower assembly in Figure 5 represents new matter that is not supported by the original disclosure. The original disclosure indicates that the species depicted in Figure 5 does not include contact between the arm and lower assembly. Such contact is disclosed in relation to the species depicted in Figure 3, and the disclosure does not indicate that the various features of the distinct species are freely interchangeable. Consistent with the disclosure, the various species are recognized as distinct structures that each includes unique features not found in the other species. Contact between the arm and the lower assembly is not disclosed as being generic to all of the species, and is not disclosed in relation to the elected species depicted in Figure 5.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of a plate mounted above the upper assembly and rigid arms that contact the lower assembly, as defined in claim 17, with a forwardly extending arm and a pair of rearwardly extending arms as defined in claim 21, or with pairs of arms that are parallel

as defined in claims 21 and 22, must be shown or the features canceled from the claims. **No new matter should be entered.** In the event that the combination of features cannot be shown without adding new matter, the features must be canceled from the claims.

If the drawings are to be corrected, corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 17, lines 13-14, requires the rigid arm to contact the lower assembly. However, the disclosure does not indicate that rigid arm 50 of elected Species III contacts the lower assembly. Rather, Figure 5 suggests that rigid arm 50 extends into the core of the gliding board and does not contact the lower assembly, in contrast to arms 20-23 of Figure 3 which do contact the lower assembly.

Claim 21 requires at least one forwardly extending arm and two rearwardly extending arms for a total of at least three arms. However, page 10, lines 19-23 of the specification indicates that only two arms 50 are present in elected Species III, and each of those two arms extends from forward to rear.

Claims 21 and 22 require the pair of arms to be parallel. However, the disclosure does not indicate that arms 50 of elected Species III are parallel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mutzhaus US 3,398,968 in view of Abondance US 5,553,884, Abondance US 5,671,940, and Guex et al. FR 2 779 658 A1.

Mutzhaus discloses a board for gliding having a central underfoot zone for receiving the foot of a user, a front zone extending from the underfoot zone to a front tip of the board, and a rear zone extending the underfoot zone to a rear tip of the board. See Figure 1. The board includes a lower assembly comprising a gliding sole 4, an upper assembly comprising a protective upper layer 5, an intermediate core 3 placed between the lower and upper assemblies, and at least one longitudinal rigid arm 7 extending downwardly and forwardly from the underfoot zone. See Figures 1 and 3 and column 3, lines 26-59. The force exerted by the user's foot is transmitted from the underfoot zone forwardly and downwardly to the lower assembly of the board.

The at least one longitudinal rigid arm 7 extending downwardly and forwardly from the underfoot zone includes a pair of parallel arms that are offset transversely and located to the front of the underfoot zone. See Figure 3. A pair of parallel longitudinal rigid arms 7 also extends downwardly and rearwardly from the underfoot zone. See Figure 3. The downwardly and rearwardly extending arms 7 are offset from one another transversely and located to the rear of the underfoot zone. See Figure 3.

Mutzhaus does not disclose edges in addition to the gliding sole of the lower assembly, an upper reinforcement layer, a plate mounted above the underfoot zone with at least one layer of elastic or viscoelastic material arranged over at least one of its

faces so as to allow displacement of the plate, and contact between the front end of the at least one longitudinal rigid arm and the lower assembly.

However, Abondance (US 5,553,884) teaches the desirability of providing the lower assembly of a gliding board with edges 6 and the upper assembly of a gliding board with an upper reinforcement layer 11. See Figures 3 and 4 and column 3, lines 49-57. From the teachings of Abondance (US 5,553,884), providing the lower assembly of Mutzhaus with edges and the upper assembly of Mutzhaus with an upper reinforcement layer would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enhance the maneuverability of the board by allowing the board to cut into the gliding surface and would enhance the strength of the board.

Abondance (US 5,671,940) teaches the desirability of mounting a plate 7 in the underfoot zone of a gliding board and providing at least one layer of viscoelastic material 6, 8 arranged over at least one of the faces of the plate 7. See Figures 1 and 2 and column 5, lines 8-21. The plate is capable of being displaced in the direction toward the lower surface of the gliding board through the effort of pressure exerted by the user's foot. See column 5, lines 22-25. From the teachings of Abondance (US 5,671,940), mounting a plate in the underfoot zone of the gliding board of Mutzhaus and providing at least one layer of viscoelastic material arranged over at least one of the faces of the plate would have been obvious to one of ordinary skill in the art at the time the invention was made. This would support bindings on the gliding board and minimize vibrations generated by the gliding board.

In addition, Guex et al. teach the desirability of arranging a rigid arm 13 to contact a lower assembly 23, 24. See Figures 7, 8, and 15 and page 7, lines 18-23. From the teachings of Guex et al., arranging the forwardly extending rigid arm of Mutzhaus to contact the lower assembly would have been obvious to one of ordinary skill in the art at the time the invention was made. This would help immobilize the arm and provide stiffness to the gliding board.

Response to Arguments

Applicant's arguments filed April 12, 2005 have been fully considered but they are not persuasive.

Applicant traversed the rejection of claims 17-22 under 35 USC 112, first paragraph, because generic details were intentionally excluded from Figures 4, 5, and 6 and it allegedly would have been readily apparent to one of skill in the art that boards represented in Figures 4, 5, and 9 would have features similar to Figure 3. However, one of ordinary skill in the art would not consider the boards of Figures 4, 5, and 9 to have identical features to the board of Figure 3, and there is no indication that contact between the arm and the lower assembly would have been a common feature. Rather, Figures 4, 5, and 9 indicate that these boards do not include such contact, which distinguishes these boards from the board depicted in Figure 3. Although generic details may have been excluded, contact between the arm and the lower assembly is not a generic detail. If Applicant desired to identify certain features as generic or allow

for the free exchange of features between the species, the original disclosure should have stated this clearly.

In regard to claim 19, the amendment has overcome the specific ground for rejection raised by claim 19. However, claim 19 remains rejected since it depends from claim 17 and includes the unsupported limitation regarding contact that is recited in claim 17.

In regard to claim 21, Applicant asserts that the recited three arms are enabled by the disclosure of the species depicted in Figures 6 and 7. However, the claimed three arms are recited in combination with the species of Figure 5, which only has two arms. The disclosure does not suggest that the species depicted in Figure 5 can be modified to include the three arms of the species depicted in Figures 6 and 7. Thus, the claimed combination is not enabled.

In regard to claims 21 and 22, Applicant contends that the recited parallel orientation of the arms is enabled because the sides of the boards are relatively parallel. However, the sides of the board do not dictate the orientation of the arms. This is evident from the species depicted in Figure 8, which includes arms that are not parallel in combination with a board with relatively parallel sides.

Applicant also traversed the rejection of claims 17, 18, and 20-22 under 35 USC 103. In doing so, Applicant has relied on the contention that Mutzhaus, as well as the additional cited references, does not disclose a "means for automatically changing the characteristics of the board while a user descends a hill." However, the accuracy of this

allegation is irrelevant since such a means is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further asserts that Abondance '884 does not teach any form of tensioning system. However, Abondance '884 is not relied on to teach this, since this structure is already established by Mutzhaus. The teachings of Abondance '884 regard edges and an upper reinforcement, and remain relevant even without a tensioning system.

In regard to Abondance '940, Applicant asserts that "a plate that can *adequately* transfer force to an arm" is not disclosed. (emphasis added) However, Applicant does not claim the degree, or adequacy, of the force transfer. The claims are satisfied as long as the plate transmits some force to the lower assembly, which the plate of Abondance does. Any weakening of the plate to allow deflection to occur would not prevent all force from being transmitted. Pressure applied to the plate by a user would be transmitted throughout the board at least to some minimal degree.

Finally, Applicant contends that Mutzhaus and Guex et al. do not disclose an arm that extends through the upper assembly. However, this feature is not explicitly claimed in any of the claims, and is merely suggested in dependent claim 19 since the arm must extend through the upper assembly in order to extend into the elastic layer of the plate that is mounted above the upper assembly. Claim 19 is not rejected under 35 USC 103.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

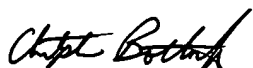
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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